

REMARKS

Claims 13-14 stand objected to because they depend on canceled claim 11. Applicant has now amended claims 13-14 so that they each depend from claim 1.

Claims 1-2, 5-10, 13-16, 18-27, 31-37 and 39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann et al. (hereafter “Rossmann”) [U.S. 20040111669].

Rossmann discloses a method including receiving a web page having a number of data elements, classifying the data elements, determining a number of related operations for each of the data elements and outputting the related operations. (Rossmann, Abstract). As Rossmann discloses, the data is extracted from the web page, the user selects one or more related operations, and the extracted data are then output to the one or more related operations, which then processes the extracted data. (Rossmann, ¶ 44). Selecting the related operation causes the extracted data to be sent to the application implementing the related operation. (Rossmann, ¶ 44). For example, using a hotel booking application, the process books a hotel by contacting the hotel booking website, makes reservations, sends confirmations to user, etc. (Rossmann, ¶ 74). It is significant to note that the processor used in the method controls and sends instructions to the remote terminals, as in the case of booking the hotel reservation.

The Applicant maintains that the examiner has not established *prima facie* obviousness of the claims. As to the first limitation of claim 1, the examiner refers to Rossman at Figure 3 and appears to assert that the wireless device **301** has a personal information manager (PIM) in which the wireless device **301** can record a destination address of a communications terminal. (Office Action, page 2, para. 5; See also Rossman, Figure 3, para [0033]-[0035] and [0060]-[0063]). However, Rossman’s statement that the wireless device will “save the phone number into a PIM” (Rossman, para. [0063]) teaches that the wireless device **301** will save the phone number locally in the PIM application within the wireless device.

With respect to the second limitation of claim 1, the examiner asserts that Ross teaches “capturing one or more telephone number records . . . using the captor computer” (Office Action, page 3, lines 1-4 *citing* Rossman at paragraphs 44-45, 60-63, 68 and 78 and *stating* that the captor computer saves a captured telephone [number] in a PIM or a telephone book). The Applicant asserts

that the examiners construction of claim 1 is untenable because it assert the very same teaching from Rossman against two very different limitations of the claim. In other words, it is inconsistent to initially assert Rossman's disclosure of *saving a captured telephone number in a PIM* as teaching "recording, on a captor computer, a destination address of a communications terminal having an electronic telephone directory" (claim 1, limitation 1) and then later assert the exact same disclosure from Rossman as teaching "capturing one or more telephone number records from a Web page displayed on the web browser using the captor computer" (claim 1, limitation 2). The examiner's position would equate the step of "recording . . . a destination address of a communications terminal" with "capturing one or more telephone number records of a Web page." Such a construction of the claim ignores the well-accepted principle of claim construction that each word of the claim must be given some meaning. Therefore, the "destination address" can not be equated with the "one or more telephone number records", and the "communications terminal" can not be equated with either the "captor computer" or the "web page." The claim involves three separate devices – a captor computer, a web page, and a communications terminal. The captor computer records the destination address of a communications terminal (limitation 1), captures one or more telephone number records from a web page (limitation 2), and sends the one or more captured telephone number records to the destination address of the communications terminal (limitation 3).

Regarding the third limitation of claim 1, the examiner does not identify where Rossman teaches a "communications terminal" or a "browser of the communication terminal" and appears to be equating the communications terminal with the captor computer. The examiner is reminded that the communications terminal and the captor computer are two separate devices, wherein the communications terminal is located at a destination address which is known to the captor computer and recorded on the captor computer. To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The examiner has stated that Rossman does not specifically teach that the destination address of the communications terminal is recorded in a web browser. (Office Action, page 3, lines 9-10). The examiner then asserts that "recording favorite destination address[es] in terms of URLs in a[s] browser's bookmarks is well known in the art." (Office Action, page 3, lines 11-12). The Applicant

asserts that recording a bookmarking a favorite web page in a browser, is not the same as “recording . . . a destination address of a communications terminal having an electronic telephone directory.” (See claim 1). First, Rossman does not teach or suggest that a web page is a communications terminal or that a web page would have a telephone directory. Secondly, the examiner cites no motivation to send a telephone number to a web page.

The examiner’s reference to “related operations” is ambiguous. Rossman teaches the following method:

A web page having a number of data elements is received in a user terminal or a server. The user terminal and/or the server classify each of the data elements into known data types. The user terminal or the server then accesses a database containing the known data types and corresponding related operations, to determine a number of related operations that correspond to each one of the known data types. The related operations are displayed to the user when the user selects one data element of the corresponding data type in the web page. When one of the related operations is selected, the user terminal or the server extracts the data from the selected data entry. The extracted data is then output to the selected related operation. The selected related operation is then executed, processes the extracted data and outputs the results. The selected related operation can be executed on the user terminal, the server or a second server.

Rossman (US 2004/0111669), paragraph [0020].

Rossman teaches that either the user terminal and/or the server classify the data elements, and that the user terminal, the server or a second server execute the related operation. Because a single selected device (i.e., the captor computer) both classifies the data and executes the related operation, there is no teaching or suggestion of “sending a message containing the one or more captured telephone number records from the captor computer to the destination address of the communications terminal.” Whereas Rossman may send output to a related operation on the same device (either the user terminal or a server), the method of claim 1 sends a message from the captor computer to a separate communications terminal. Reconsideration and withdrawal of the rejection is respectfully requested.

Regarding claim 2, the examiner again asserts the same passages, i.e., Rossman at paragraphs 60-63, as disclosing the step of “receiving, in the communications terminal, the message containing the one or more captured telephone number records from the captor computer; and recording the one

or more telephone number records into the electronic telephone directory of the communications terminal.” (Office Action, page 4, lines 1-6). The rejection fails to even assert the identity of the communications terminal as distinct from the captor computer.

Regarding claims 5-6, the examiner asserts that the wireless device **301** (Figure 3) or the wireless device **400** (Figure 4) is the communications terminal as set out in claim 1. However, in making out the rejection against claim 1, the examiner already asserted that the wireless device was the captor computer. The Applicant asserts that the examiner may not ignore the plain meaning of the claim language and cite a single wireless device as being both of two devices that are expressly set out in the claims.

Regarding claims 7 and 10, the Applicant reasserts that a common URL bookmark is not a disclosure of a destination address for a communications terminal having electronic telephone directory.

Regarding claim 20, the examiner cites only to claim 17 of Rossman, which is set out in its entirety below:

17. The system of claim 15, wherein the user terminal includes at least one of a group consisting of a personal digital assistant (PDA), a telephone, a cellular telephone, a two-way pager, a computer, a website, and a server.

Rossman’s claim 17 does not support the examiner’s assertion that “Rossman teaches that the PIM destination of the captured telephone numbers can be located at a remote website or a remote communications terminal”. (Office Action, page 7, para. 14). Claim 17, alone or in combination with any of the related claims, does not teach a PIM, “a remote website”, or “a remote communications terminal.” A hindsight reconstruction of the invention does not establish a proper obviousness rejection. Reconsideration and withdrawal of the rejection is requested.

The Applicant reasserts the foregoing arguments in support of similar limitations found in claims 16, 21-27, 31-37 and 39. Reconsideration and withdrawal of the rejection is requested.

Claims 3-4 stand rejected under 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER Rossmann et al. (hereafter “Rossmann”) [U.S. 20040111669], as applied to claims 1-2, 5-10, 13-16, 18-27, 31-37 and 39 above, further in view of Official Notice. Claims 3 and 4 depend from claims 1 and 2 and are patentable for at least the same reasons. Reconsideration and withdrawal of the rejection is requested.

The Applicant requests entry of any amendments and reconsideration of the pending claims. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 090447/AUS920010511US1 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,

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